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| 10/037,445 | 12/31/2001 | Jacquelyn Martino | US 010685 | 4835 |

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BRIARCLIFF MANOR, NY 10510

EXAMINER

ROBINSON, GRETA LEE

ART UNIT

PAPER NUMBER

2168

MAIL DATE

DELIVERY MODE

04/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/037,445

Applicant(s)

MARTINO ET AL.

Examiner

Greta L. Robinson

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6, 8-11, 13-15 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8-11, 13-15 and 21-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the appeal brief filed on January 14, 2008, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Tim T. Vo/

Supervisory Patent Examiner, Art Unit 2168

2. Claims 1, 3-6, 8-11, 13-15, 21, 22 and 23 are pending in the present application.

Drawings

3. The drawings filed August 8, 2006 and June 9, 2005 are objected to because they are informal. The descriptive elements appear handwritten and uneven. For

example note Figure 1B system 100, text should be typed. Figure 3, reference character 304 text overlaps boundary of lines within flowchart. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

Replacement Drawing Sheets

Drawing changes must be made by presenting replacement sheets which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments section, or remarks, section of the amendment paper. Each drawing sheet submitted after the

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filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). A replacement sheet must include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of the amended drawing(s) must not be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and within the top margin.

Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, may be submitted or required by the examiner. The annotated drawing sheet(s) must be clearly labeled as "Annotated Sheet" and must be presented in the amendment or remarks section that explains the change(s) to the drawings.

Timing of Corrections

Applicant is required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings MUST be filed within the THREE MONTH shortened statutory period set for reply in the "Notice of Allowability." Extensions of time may NOT be obtained under the provisions of 37 CFR 1.136 for filing the corrected drawings after the mailing of a Notice of Allowability.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 3-6, 8-10, 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding independent system claim 1, the specification provides evidence at page 4 line 7-23, that the "system" may be implemented as software. If elements would have been reasonably interpreted in light of the disclosure by one of ordinary skill as software alone, the claim is directed to software *per se* and is nonstatutory. Claims 3-5 and 21 are rejected based on dependency.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e. abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Regarding independent apparatus claim 6, the claim omits an operational function and merely recites an arrangement of structures. The claim is directed to descriptive material *per se* which is nonstatutory. Claims 8-10 and 22 are rejected based on dependency.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 3, 8 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the nature" in line 2. There is insufficient antecedent basis for this limitation in the claim.

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Claim 8 recites the limitation "the nature" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the nature" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. Claims 1, 3-6, 8-11, 13-15, and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiyoshi US Patent 6,601,067 B1 in view of Schindler US Patent 6,199,064 B1.

Regarding claim 1, Hiyoshi teaches a system for producing a list of results, the system comprising "a sort controller receiving a plurality of information items regarding content" note *sort/merge processor 10* figure 1. Hiyoshi teaches *input files* for receiving a plurality of information, information is read through *file reading unit 15* figure 1. Hiyoshi teaches "wherein, to produce the list of results, the sort controller sorts the information items" note *sort/merge execution unit 18* figure 1, also see column 4 lines 10-20. Hiyoshi does not specifically teach "primary sort key and a secondary sort key derived from predetermined user sorting preferences for a current user task context and content type"; however this feature is taught by Schindler. Schindler teaches items are sorted by the value of their context and that the context is used to define the primary sort key and the secondary sort key [see: column 7 lines 45-65 items are sorted by the value of their context; column 8 lines 39-66; and column 11 lines 30-39 "using the context to define the primary sort key" and "deriving a secondary sort key"]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Schindler with Hiyoshi because Schindler teaches how the primary and secondary sort keys are derived from a function of the context for sorting which is predetermined.

11. Regarding claim 3, "wherein a primary sort key is selected by the user and a secondary sort key is selected based on the nature of the current user task" [note: Hiyoshi

Figure 1 rule setting unit 14 and extraction criteria 13; also note Schindler, col. 11 lines 29-39].

12. Regarding claim 4, "wherein a change in the current user task context is inferred from a change of the primary sort key by the user" [see: Schindler Figure 9 (435)].

13. Regarding claim 5, "wherein the plurality of information items are displayed in an order determined by the sort controller" [note: Hiyoshi, column 4 lines 28-32 and lines 53-55].

14. The limitations of claims 6 and 8-10 have been addressed above except for the following: an audio receiver, Internet access, and remote control device [note: Hiyoshi input device 28 figure 2, column 5 lines 25-34].

15. The limitations of method claims 11 and 13-15 parallel system claims 1 and 3-5; therefore they are rejected under the same rationale.

16. Regarding claims 21-23, a user interface communicably coupled to the sort controller to receive user input identifying the current user task context [note: Hiyoshi, column 4 lines 40-55; also note interface 26 Figure 2].

17. Claims 1, 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al. US Patent Application No. 2003/0159147 A1 in view of Burkhard US Patent 5,924,091. (note: Burkhard was cited on form PTO-892 paper no.0425005)

Regarding claim 1, Young et al. teaches a system for producing a list of results [note: "FIGS. 14-17 show Theme function screen 104. The Theme function allows the viewer to quickly sort the downloaded schedule and display a subset schedule based on a subject of interest" paragraph 108], the system comprising:

a sort controller receiving a plurality of information items regarding content [note: paragraph 0135 "system/controller 180"],

wherein, to produce the list of the results, the sort controller sorts the information items using a primary sort key and a secondary sort key derived from predetermined user sorting preferences doe a current user task context and content type for the information items [note: paragraph 118 "allow logical sorting of the schedule" ; paragraph 0108 "listings sorted first by major themes, second by topic(s) within a theme"].

Although Young et al. teaches the invention substantially as cited above, they do not explicitly teach a primary sort key and a secondary sort key. However, Burkhard teaches a primary sort key and a secondary sort key so that additional information may be associated with each key [see: column 9 line 39 through column 10 line 6]. It would have been obvious to one of ordinary skill at the time of the invention to have combined Burkhard with Young et al. since radix sorting is a well known sorting technique, and

would allow first and secondary topics selected in Young et al. to be properly identified for sorting.

18. The limitations of claim 6 have been addressed in claim 1 except for the following: an audio receiver, Internet access, and remote control device [note: Young et al. paragraph 0141 note remote controller 212, TV device and CPU 228].

19. The limitations of method claim 11 parallel system claim 1; therefore it is rejected under the same rationale.

Response to Arguments

20. Applicant's arguments filed January 14, 2008 have been fully considered but they are not persuasive.

In the response Applicant argued, independent claims 1, 6 and 11 recite *a primary sort key and a secondary sort keys derived from predetermined user sorting preferences for current user task context and a content type*. Applicant argued the secondary reference, Schindler does not teach predetermined user sorting preferences for a current user task context and content type. However the examiner respectfully disagrees. Schindler teaches "using the context to define the primary sort key" and "deriving a secondary sort key" see column 11 lines 30-39. Schindler et al. uses the position of the data as a sort key [column 1 lines 47-54]; however the relationship of the keys are based on implementation of code or a particular algorithm [see: col. 1 lines 55-67; and prototype pseudo-code fragments col. 7 and 8]. Schindler's teaching of the

ability to define the sort key provides for the limitation of "predetermined user preference". Schindler provides for the concept of information items being sorted by the value of their context through bucketsort function and gives an example see column 7 lines 45-65 and Figure 9 step 425 SORT DATA BY CONTEXT. Note, the value of the context is seen as the content . Like the present invention, in Schindler the task context infers the content type [see: original specification page 2 lines 18-20 "a sort tool employing context-dependent primary and secondary sort keys among and across content types"]. Schindler et al. teaches the optional use of a *seconday index* to sort larger blocks of data for a particular sorting task [see: column 9 lines 25-64]. The sorting preferences are predetermined because they are defined by the end user through code.

Applicant is reminded that during patent examination the pending claims are given the broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F. 3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim. In the present case a statement of intended use or field of use is not limiting.

Note *new* rejections cited under 35 USC 101, 35 USC 112 second paragraph, and 35 USC 103(a) *Young et al. in view of Burkhard et al. supra.*

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ito US Patent Application Publication No. 2001/0042030

Allport US Patent 6,483,548 B1

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Tim T. Vo/

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Supervisory Patent Examiner, Art
Unit 2168

/Greta L. Robinson/
Primary Examiner, Art Unit 2168

April 01, 2008